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APPLICATION NO.	FILING DATE	POST NAME OF INVENTOR	ATTORNEY DOCKET NO.	CLASSIFICATION
09/864,873	05/25/2001	John J. Rossi	1954-330	2281

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WASHINGTON, DC 20005

EXAMINER

LACOURCIERE, KAREN A

ART UNIT	PAPER NUMBER
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1635

13

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

FILE COPY

**Office Action Summary**

Application No.

09/864,873

Applicant(s)

ROSSI ET AL.

Examiner

Karen A. Lacourciere

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The objection to the specification set forth in the prior Office action, mailed 12-31-2002, is withdrawn in response to Applicant's amendments filed 03-31-2003.

### ***Claim Rejections - 35 USC § 112***

The rejections of record of claims 1-10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, set forth in the prior Office action mailed 12-31-2002, is withdrawn in response to Applicant's amendments filed 03-31-2003.

### ***Claim Rejections - 35 USC § 102***

The rejection of record of claims 1-5 and 8-10 under 35 U.S.C. 102(b) as being anticipated by Browning et al. (J. Virol. 73(6): 5191-5195, 1999, cited on PTO form 1449 filed August 2, 2001), set forth in the prior Office action (mailed 12-31-02) is withdrawn in response to Applicant's amendments filed 03-31-2003.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michienzi et al. Nucleic acids Symposium Series No. 41, pages 211-214, 1999, cited on PTO form 1449 filed August 2, 2001) in view of Browning et al. (J. Virol. 73(6): 5191-5195, 1999, cited on PTO form 1449 filed August 2, 2001) and Stauber et al. (Virology, 252, p 126-136, 1998, cited on PTO form 1449 filed August 2, 2001).

Michienzi et al. teach a nucleolar delivery system for delivery of a Rev decoy wherein the delivery system comprises a Rev decoy sequence that has replaced an apical loop of U16snoRNA and a C/D box. Michienzi et al. further disclose wherein this decoy is expressed from a vector in a cell under control of a

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pol III promoter. Michienzi et al. do not teach a Tat decoy comprised in their nucleolar delivery system.

Browning et al. teach a Tat decoy sequence comprising SEQ ID NO:12.

Stauber et al. teach that HIV Tat protein is active in the nucleolus.

It would have been obvious to one of ordinary skill in the art to substitute the Rev decoy sequence in the nucleolar delivery system taught by Michienzi et al. with a Tat decoy sequence, as taught by Browning et al. to provide a vector effective to deliver the Tat decoy to the nucleolus because Rev and Tat were both known to be functional in the nucleolus. One of ordinary skill in the art would have been motivated to substitute the Tat decoy taught by Browning et al. for the Rev decoy taught by Michienzi et al. to make a chimeric RNA for delivery of Tat to the nucleolus because Michienzi et al. teach that this system is effective to deliver a decoy to the nucleolus to investigate the function of the protein which binds to the decoy and Stauber et al. teach that Tat has a role in the nucleolus. One of ordinary skill in the art would have been motivated to make the chimeric Tat decoy claimed in order to further define the role of tat in the nucleolus and to provide a vector to deliver the Tat decoy taught by Browning et al. to a cellular compartment where the target of the Tat decoy is active.

Therefore, the invention of claims 1, 2 and 4-10 would have been obvious as a whole to one of ordinary skill in the art at the time the instant invention was made.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523. The examiner can normally be reached on Monday-Friday 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere  
June 16, 2003

  
KAREN LACOURCIERE  
PATENT EXAMINER